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PATENT APPLICATION
Attorney Docket No.: 18405-115

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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APR 22 2003
GROUP 1700

APPLICANTS: Glen Jorgensen, *et al.* ART UNIT: 1723
SERIAL NO.: 09/970,547 EXAMINER: David L. Sorkin
FILING DATE: October 3, 2001
FOR: MULTIPLE PROCESSING CHAMBER SET AND USE THEREOF

April 18, 2003
New York, New York

Commissioner for Patents
Washington, D.C. 20231

TRANSMITTAL LETTER

Sir:

Transmitted herewith for filing in the present application are the following documents:

- ☒ Response to Requirement For Restriction (5 pgs.); and
- ☒ a Return Postcard.

The Commissioner is hereby authorized to charge any additional fees that may be due to Deposit Account No. 50-0311, Reference No. 18405-115. A duplicate copy of this transmittal letter is enclosed.

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch is respectfully requested to contact the undersigned at 212/692-6803, New York, New York.

Date: April 18, 2003

Respectfully submitted,

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#7/Response
4/24/03
J. S. Butler



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RESPONSE TO REQUIREMENT FOR RESTRICTION

Applicant hereby confirms the *provisional* election of claims 1-19 for examination, but traverses the requirement for the following reasons.

The Action indicates that the inventions of Groups I-IV are allegedly distinct in that:

- the invention recited in the claims of Groups I and II are related as combination and sub-combination;
- the invention recited in the claims of Groups I and III are related as sub-combinations usable together in a single combination;
- the invention recited in the claims of Groups I and IV are related as process and apparatus for its practice;
- the invention recited in the claims of Groups II and III are related as sub-combinations usable together as a combination;
- the invention recited in the claims of Groups II and IV are related as process and apparatus for its practice; and

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- the invention recited in the claims of Groups III and IV are related as process and apparatus for its practice.

Applicant submits the following in response thereto.

According to M.P.E.P. § 806-05(c), the alleged combination (Group II) and sub-combination (Group I) may be distinct if (1) the combination as claimed does not require the particulars of the sub-combination as claimed for patentability and (2) that the sub-combination has utility by itself or in other combinations. To that end, the Action reasons that the combination (Group II) does not require the sub-combination (Group I) of “central hubs constructed and arranged to define passages”, and that the sub-combination has separate utility such as pumping fluid in a static situation unrelated to centrifuging. Applicant submits, that the Action fails at least to meet the requirement set out in (2) above. Specifically, the sub-combination does not have separate utility as alleged by the Action since the invention of Group I requires, in the very least, to be used with a centrifuge (bowl) as recited in the claim. Static or dynamic pumping is only a function of the rotation/non-rotation of the centrifuge. However, even in static pumping situations, the centrifuge is used, for example, as an enclosure for the chambers to push against when moving fluids and also may act as a pressure vessel when air expression is used to pump fluid through the processing chambers. Accordingly, Applicants respectfully submit that the invention recited in Group I is not distinct from the invention recited in Group II.

The Action also alleges that, pursuant to M.P.E.P. § 806.05(d), the alleged sub-combinations of Groups I and III are distinct since the invention in each Group is separately usable. Specifically, the Action alleges that the connector recited in the claims of Group III has separate utility such as “connecting elongated tubes” or “connecting chambers which do not have axial openings”. Applicants respectfully submit, however, that the Action’s reliance on the connector of Group III being suitable for “connecting elongated tubes” or “connecting chambers which do not have axial openings” is not reasonable. With regard to “connecting elongated tubes”, Applicants submit that this is unreasonable since the centrifuge chambers may be considered “elongated tubes”. Moreover, the use of the connector of Group III for “connecting

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chambers which do not have axial openings” is not reasonable since the connector is still being used to connect chambers as recited in the claims of the group. Applicants are puzzled as to how such a proposition may be construed as being separately usable. Accordingly, Applicants respectfully submit that the invention recited in Group I is not distinct from the invention recited in Group III.

The Action also indicates that the process claims of Group IV are distinct from the apparatus claims of Group I or Group II since each apparatus as claimed can be used to practice another materially different process. M.P.E.P. § 806.05(e). The Action alleges that the apparatus recited in the claim of Group I can be used to pump fluid in a static condition unrelated to centrifuging, and the apparatus recited in the claims of Group II can be used to process a single “sample” in multiple stages by passing it serially through a plurality of the chambers. Applicant submits that neither explanation given in the Action suffices to meet the requirement of distinction as set out in M.P.E.P. § 806.05(e) to make those inventions distinct from the invention recited in Group IV. Specifically, the pumping of fluid in a static condition is not a “materially different process” from the process recited in Group IV. The “expressing” of a plurality of supernatants and/or a plurality of pellets, as recited in the claims of the group, does not require to be performed dynamically, as would be done if the centrifuge was rotating – it may also be done statically. Thus, “static” pumping cannot be considered a materially different process.

Moreover, although the apparatus of Group II may possibly be used to process a single sample in multiple stages, it is also not a “materially different process”. The single sample may be construed to be “a plurality of samples” to be added to a plurality of processing chambers at different times. There is no language in the process according to Group IV that presents a timing of, for example, adding a single sample to each chamber at a different time or multiple samples at the same time. Accordingly, Applicants respectfully submit that the invention recited in either Group I or Group II is not distinct from the invention recited in Group IV.

The Action further alleges that the invention of Group III is distinct from the invention of Group IV, since either: the connector recited in Group III is not referred to at all in the method

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recited in Group IV; or that the connector of Group III has separate utility such as “connecting elongated tubes” or “connecting chambers which do not have axial openings.” The requirements for determining distinct invention for a process and apparatus for its practice is set out in M.P.E.P. §806.05(e), which states that the apparatus and process inventions may be distinct if it can be shown that either (1) the process as claimed can be practiced by another materially different apparatus, or by hand, or (2) that the apparatus as claimed can be used to practice another and materially different process. Applicants submit that there is no requirement in M.P.E.P. § 806.05(e) to prove distinctness that the process claims must refer to language recited in the apparatus claims.

With regard to the proposition that the apparatus recited in the claims of Group III is capable of practicing the “materially different” processes of “connecting elongated tubes” or “connecting chambers which do not have axial openings”, Applicants submit that such propositions are unreasonable since neither process is materially different from that recited in the claims of Group IV, since each proposition given in the Action for meeting the distinctiveness requirement is performed either expressly or inherently by the process recited in Group IV. Specifically, Applicants respectfully submit that the chambers may be considered, for example, “elongated tubes”, and thus, Group IV already performs the process of connecting “elongated tubes”. With regard to the remaining proposition that the apparatus of Group III is capable of “connecting chambers which do not have axial openings”, Applicants also submit that this is also unreasonable since this cannot be considered a materially different process -- the connector is still being used, for example, in the claims of Group IV (see claim 26, for example) to connect chambers. Whether the chambers include axial openings or not cannot be considered, in Applicants’ opinion, “materially” different. Accordingly, Applicants respectfully submit that the invention recited in the claims of Group III are not distinct from the invention recited in Group IV.

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CONCLUSION

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At least in view of the foregoing remarks, Applicants respectfully request that the restriction requirement on the claims be withdrawn, and that the Office consider and examine all 34 claims of the subject application. Accordingly, Applicants respectfully request favorable consideration and early passage to issue of the present application.

It is believed that no fees are due in connection with filing this Response. In the event that it is determined that fees are due, however, the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-0311.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 692-6803. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brian P. Hopkins".

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